2145

IMAGE

TRANSMITTAL LETTER (General - Patent Pending)	Docket No. 115274-017

In Re Application Of: **Levergood et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/548,235 ✓	04/12/2000	Patrice L. Winder	24573	2155	6069

Title: **WEB ADVERTISING METHOD**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Supplemental Response (6 Pages); and Return Receipt Postcard.

in the above identified application.

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- ☐ A check in the amount of is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **02-1818** as described below.
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Signature

Dated: **September 7, 2004**

Jeffrey H. Canfield
Reg. No. 38,404
Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, Illinois 60690-1135
Telephone: (312) 807-4233

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Levergood et al.
Appl. No.: 09/548,235
Conf. No.: 6069
Filed: April 12, 2000
Title: WEB ADVERTISING METHOD
Art Unit: 2155
Examiner: Patrice L. Winder
Docket No.: 113948-026

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL RESPONSE

Sir:

The present remarks are submitted in addition to the submission filed with the RCE filed in the above identified case on April 22, 2004. These remarks are intended to address the issue raised in the interview with the Examiner conducted by Applicants' attorney on July 22, 2004, 2004. Applicants have already addressed the prior art issues by swearing behind Catledge et al., Characterizing Browsing Strategies In The World Wide Web, and Novick, The Clickstream in the §1.131 Affidavit of George Winfield Treese filed with the RCE.

They only issue remaining in the case is the rejection of the claims under 35 U.S.C. §112 first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to make or use the claimed invention. Examiner contends that the Applicants have not provided a sufficiently detailed disclosure of the steps of "charging for advertising based on link traversals to the page" and "measuring the number of sales or transactions resulting from link traversals." This despite verbatim recitation of the subject phrases within the specification.

Examiner correctly states that it is generally understood that the state of the art at the time of invention as understood by the inventor can be determined by the degree of detail in the disclosure and that which is left for one of ordinary skill in the art to perform is presumed to be within the skill in the art to perform. However, Examiner goes too far when she states that Applicant has provided no enabling detail of this alleged non-obvious process by which to

"charge for advertising based on link traversals to the page" and "measure the number of sales or transactions resulting from link traversal" and subsequently declares that these steps are presumed to by within the skill of the art.

The phrase "charge for advertising based on link traversal to the page is associated with independent claims 1 and 6. The phrase "measuring the number of sales or transactions resulting from link traversal" are associated with independent claim 5, however, the disclosure of each step occurs within the same paragraph of the specification and the sufficiency of the disclosure of each step will be addressed in unison.

Examiner's argument is that, given the alleged paucity of disclosure of the steps of "charging for advertising based on link traversals to the page," and "measuring the number of sales or transactions resulting from link traversals," such a step must have been within the level of skill possessed by those of ordinary skill in the art. Therefore the invention either was not enabled or was obvious. Examiner's position actually raises two distinct issues. 1) Is the disclosure in the specification sufficient to satisfy the enablement requirement of §112 first paragraph, and 2) if one must rely on the level of skill in the art for purposes of satisfying the enablement requirement is not the claim then made obvious for purposes of applying §103?

Applicants will first address the enablement issue, then applying all of the assumptions regarding the level of skill in the art necessary to consider the claims enabled, Applicants will show that even when such assumptions are applied, the claims, are non-obvious in terms of applying §103.

Taking claims 1 and 5 as examples, claim 1 calls for two distinct steps: Determining link traversals to a page; and charging for advertising based on link traversals to the page. Claim 5 calls for determining link traversals leading from an advertisement page; and measuring the number of transactions resulting from link traversals from the advertisement to the page. As Examiner is aware, Applicants rely on the paragraph spanning the bottom of page 14 to the top of page 15 of the specification as support for the steps of charging for advertising based on link traversals to the page and measuring the number of transactions resulting from link traversals from the advertisement to the page. For convenience the paragraph is reproduced below.

> Additionally, the server may, at any given time, track access history within a client-server session. Such a history profile informs the service provider about link transversal frequencies and link paths followed by users. This profile is produced by filtering transaction logs from one or more servers to select only

> transactions involving a particular user ID (UID). Two subsequent entries, A and B, corresponding to request from a given user in these logs represent a link traversal from document A to document B made by the user in question. This information may be used to identify the most popular links to a specific page and to suggest where to insert new links to provide more direct access. In another embodiment, the access history is evaluated to determine traversed links leading to a purchase of a product made within commercial pages. This information may be used, for example, to charge for advertising based on the number of link traversals from an advertising page to a product page or based on the count of purchase resulting from a path including the advertisement. In this embodiment, the server can gauge the effectiveness of advertising by measuring the number of sales that resulted from a particular page, link, or path of links. The system can be configured to charge the merchant for an advertising page based on the number of sales that resulted from that page.

A careful parsing of this paragraph leaves no doubt that the step of "charging for advertising based on link traversals to the page" is described in sufficient detail to enable one of ordinary skill in the art at the time the invention was made to practice the claimed invention.

According to the above paragraph a server tracks access history within a client-server session. Tracking access history in this manner provides information to a service provider about link traversal frequencies and the link paths followed by users. In other words, the server tracks the links followed by users during the course of client-server sessions. This is accomplished by filtering transaction logs from one or more servers to select only transactions involving a particular user ID.

A link traversal from a document A to a document B is defined a two subsequent entries A and B corresponding to a given user. Again, such entries may be gleaned from the transaction logs stored by the one or more servers. Access history (the links followed by various users within client-server sessions) may be evaluated to determine traversed links which lead to the purchase of a product made within commercial pages.

Thus, assume a user within a client-server session traverses a link from document A, to document B as described above. Suppose that document A is a web advertisement and document B is a commercial web page in which the user may place an order to purchase a product. Assume further that the user does in fact place an order for a product from document B. An embodiment of the present invention tracks the user's link traversal from document A to document B. The fact that the user made a purchase at document B is also recorded.

Clearly the amount of traffic (i.e. the number of link traversals) from the advertising page (document A) to the product page (document B) is an indication of the effectiveness of the advertisement contained in document A. The number of sales resulting from such link traversals is an even stronger indication.

Advertisers want their ads to be seen by the widest audience possible. Therefore, advertisers are willing to pay more for advertising placements that they know will reach their target audience than they are for placements where audience penetration is less certain or is known to be less. Accordingly, television ads are more expensive during the Super Bowl than they are during syndicated re-runs of a sitcom in the early hours of a Wednesday morning. Advertising rates for newspapers and magazines are based on circulation. The rental rate for billboard space is more expensive along highly traveled thoroughfares than on rural highways.

In sum, advertising outlets charge for advertising based on quantifiable measures of audience size and market penetration. They also want feedback on the effectiveness of advertising campaigns so they can adjust their strategies in the future. Applicants respectfully submit that at the time the present invention was made a step of charging for advertising based on a measurable quantity that gauges the potential size of the audience that would view an advertisement was enabling on its face. Advertisers placing the ad and the media outlet distributing the ad would have known that the cost of an ad would be directly related to the market gauge being measured.

From the foregoing, it should be clear that the disclosure of the specification was sufficient to enable one of ordinary skill in the art at the time the invention was made to charge for advertising based on link traversals to a page, and to measure the number of sales or transactions resulting from link traversals. It remains to determine whether the claims would have been obvious given the knowledge available to those of ordinary skill in the art at the time the invention was made.

In the above discussion of enablement the only skills imputed to those of ordinary skill in the art was that of charging for advertising based on some quantifiable measure of market penetration, such as newspaper or magazine circulation, TV ratings, billboard location, or the like and measuring the effectiveness of advertising by correlating ads with products sold. It was not known at the time the present invention was made to measure the success of web based advertising by counting the number of times users traverse a hypertext link from an

advertisement page to a product page, then charging for advertising based on the traversal count. Nor was it obvious to measure the number sales or transactions resulting from link traversals. Examiner has provided no prior art that predates Applicant's date of invention that teaches or monitoring link traversals or suggests using link traversals as a gauge of marketing success.

At the time of the invention, the use of the Internet as a sales and marketing tool was in its infancy. Early adopters were struggling to find ways to capitalize on this new communications tool. The present inventors successfully developed systems and methods to track user sessions with web servers and monitor the paths followed by users through the world wide web. They also developed applications for commercially exploiting the data obtained by monitoring such usage patterns. Among the applications developed by the inventors was charging for advertising based the number of link traversals leading to a page. And in a variant of this application, measuring the number of sales or transactions resulting from link traversals. These applications were not obvious at the time, because prior to the inventors' efforts the ability to gather the information necessary to implement such applications did not exist.

In a final note on non-obviousness, Applicants would like to point out that 35 U.S.C. §103 applies to an entire claim taken as a whole. All claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). With regard to the present claims, Applicants note that even if the individual steps of charging for advertising based on link traversals to a page or measuring the number of sales or transactions resulting from link traversals would have been obvious at the time of invention (a point Applicants strenuously deny), the claims of which these elements form a part, nonetheless, when taken as a whole, are not taught or suggested by the prior art. Examiner has cited not art that predates Applicants' invention that teaches or suggests the combined steps of the methods claimed in the present application.

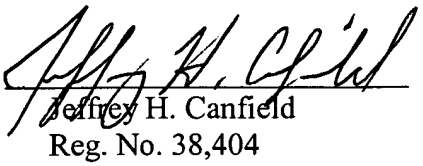
Accordingly, Applicants respectfully submit that the subject matter of each pending claim is supported in the specification in sufficient detail to enable one of ordinary skill in the art at the time the invention was made to practice the claimed invention. The alleged lack of specificity and detail in the disclosure of the specification does not lead to the conclusion that the claimed subject matter is obvious under 35 U.S.C. §103. For these reasons the claims are allowable and Applicants urge Examiner to move the case to issue.

Applicant therefore requests that the Examiner allow the claims move the application to issue. However, if there are any remaining issues the Examiner is encouraged to call Applicants' attorney, Jeffrey H. Canfield at (312) 807-4233 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Jeffrey H. Canfield
Reg. No. 38,404
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4233

Dated: September 7, 2004